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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,028	09/11/2002	Kirk Barker	29370.20	7563
27683	7590	06/16/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			PHAN, JOSEPH T	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,028

Applicant(s)

BARKER ET AL.

Examiner

Joseph T. Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 7-23 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/146,168. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to the same invention but recited in a different manner.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 7-23 rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz et al., Patent #6,661,879.

Regarding claim 1, Schwartz teaches a method for on-demand recording of a voice session by a telephone recording device in a telecommunication network, the method comprising:

- establishing a voice session between the telephone recording device and at least one communication device(Fig.1);
- automatically temporarily storing voice data representing the voice session in a memory buffer device in a storage server, wherein the temporary storing is automatically initiated upon the establishment of the voice session(col.10 line 38-col.11 line 9)
- instructing the telephone recording device to store the voice data, wherein the instruction can occur at any time during the voice session so long as the voice session has not been terminated, and wherein the instruction to store the voice data is initiated by a user of the telephone recording device during the voice session(*col.11 lines 10-18; the voice session between the user and central archive has not been terminated*); and
- processing the voice data by the telephone recording device to be transmitted to and saved at a storage server, wherein the saved voice data is available for on-demand replay(col.10 lines 55-60).

Regarding claim 2, Schwartz teaches the method of claim 1 further comprising duplicating the voice data at the telephone recording device and storing in a memory buffer device contained therein(col.10 lines 38-col.11 line 9).

Regarding claim 3, Schwartz teaches the method of claim 1 further comprising: persistently storing the temporarily stored voice data in the storage server only after the instruction for recording is received(col.10 lines 38-col.11 line 9).

Regarding claim 4, Schwartz teaches the method of claim 1 wherein the processing further comprises digitizing the voice data(col.6 lines 50-60).

Regarding claim 7, Schwartz teaches the method of claim 1 wherein the voice session is carried out through two local switch devices directly connected therewith, a first local switch device servicing the telephone recording device and a second local switch device servicing the communication device(Fig.1)

Regarding claim 8, Schwartz teaches the method of claim 7 wherein the first local switch device is connected to the storage server(Fig.1).

Regarding claim 9, Schwartz teaches the method of claim 7 wherein the first local switch device is connected to a call manager server for managing the voice session (Fig.1)

Regarding claim 10, Schwartz teaches a system for on-demand recording of voice data(col.5 lines 35-40), comprising:
at least one local switch device for establishing a voice session between a communication device and a telephone recording device (Fig.1);

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a memory buffer for temporarily storing voice data representing the voice session(20 Fig.1);

a storage server(22 or 26 *fig.1; depends on what method is used to transfer the voice conversation*) connected to the local switch device(16 Fig.1) for saving the voice data sent by the telephone recording device(20 *Fig.1; central archive facility can be read as a telephone recording device*);

a save initiator for dynamically initiating the voice data recording during the voice session, wherein the recording can be started by a user at any time during the voice session, and wherein the recording saves the entire voice session by copying the voice data from the memory buffer to the storage server(col.10 lines 38-col.11 line 18; *the voice session between the user and central archive has not been terminated*); wherein the telephone recording device processes and transmits the voice data to the storage server through the local switch device(col.10 lines 55-60).

Regarding claim 11, Schwartz teaches the system of claim 10 wherein the telephone recording device processes and transmits the voice data to the storage server through the local switch device without involving a private branch exchange (PBX) (Fig.3 of Schwartz).

Regarding claim 12, Schwartz teaches the system of claim 10 wherein the local switch device is a hub device (CO in Fig.5 is a hub).

Regarding claim 13, Schwartz teaches the system of claim 10 wherein the local switch device is a local switch (Fig.2).

Regarding claim 14, Schwartz teaches the system of claim 10 wherein the telephone recording device includes a processor for digitizing the voice data(col.6 lines 50-60).

Regarding claim 15, Schwartz teaches the system of claim 10 wherein the save initiator is on the telephone recording device (col.10 lines 38-col.11 line 18).

Regarding claim 16, Schwartz teaches a telephone recording device used in an on-demand voice data recording system(col.5 lines 35-40), comprising:
means for establishing a voice session with a communication device through communications with at least one local switch device; a save initiator on the telephone recording device for dynamically initiating the voice data recording at any time during the voice session, wherein the voice data represents the voice session from the beginning of the voice session (col.10 lines 38-col.11 line 18);
a processing means for digitizing the voice data into a digital form and storage buffering means for automatically saving the digitized voice data(col.6 lines 50-60).; and
a transmission module for sending the digitized voice data from the storage buffering means to a storage server connected to the local switch device in response to a signal from the save initiator(col.10 lines 55-60).

Regarding claim 17, Schwartz teaches a system for on-demand recording of voice data, the system comprising:
a telephone recording device connected to a first local switch device, at least one communication device connected to a second local switch device for establishing a

voice session with the telephone recording device through a communication link between the first and second local switch device(Fig.1)

a save initiator for dynamically initiating the voice data recording during the voice session in real time in response to user input received at any time during the voice session, wherein the voice data represents the voice session from the beginning of the voice session (col.10 lines 38-col.11 line 33); and

a storage server connected to the first local switch device for saving the voice data sent by the telephone recording device, wherein the telephone recording device processes and transmits the voice data to the storage server through the first local switch device(col.10 lines 55-60).

Regarding claim 18, Schwartz teaches a system for peer-to-peer on-demand recording of voice data(col.5 lines 35-40), the system comprising:

a telephone recording device and at least one communication device connected to a local switch device(Fig.1), the telephone recording device having:

a save initiator for dynamically initiating the voice data recording after a voice session is established between the telephone recording device and the communication device(fig.4-6), wherein the voice data is a representation of the entire voice session, and wherein the save initiator is configured to initiate the recording in response to user input received at any time until the voice session is terminated (col.10 lines 38-col.11 line 33);

processing means for packetizing the voice data and memory buffer for temporarily storing the voice data ; and storage server connected to the local switch device for

storing the temporarily saved voice data sent by the telephone recording device(24 Fig.1 and col.10 lines 38-col.11 line 33)

Regarding claim 19, Schwartz teaches the system of claim 18 further comprising a replay means on the telephone recording system for playing back the stored voice data(24 Fig.1 and col.10 lines 38-col.11 line 33)

Regarding claim 20, Schwartz teaches the system of claim 18 wherein the memory buffer is on the telephone recording device (24 Fig.1 and col.10 lines 38-col.11 line 33)

Regarding claim 21, Schwartz teaches the system of claim 18 wherein the memory buffer is on the storage server(24 Fig.1 and col.10 lines 38-col.11 line 33)

Regarding claim 22, Schwartz teaches a method for storing a peer-to-peer telephone conversation session between a coordinating user using a telephone recording device and at least one regular user using at least one communication device which does not have a recording feature, the method comprising: establishing the peer-to-peer telephone conversation session between the telephone recording device and the communication device through a local switch device; temporarily saving voice data representing the entire session in a memory buffer of the telephone recording device; and instructing, by the user, during the session and before the session ends, the telephone recording device to store the temporarily saved voice data in a storage server connected to the local switch device(24 Fig.1 and col.10 lines 38-col.11 line 33)

Regarding claim 23, Schwartz teaches the method of claim 20 further comprising replaying the stored voice data(col.5 lines 35-40).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP
June 7, 2005



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